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EXAMINER

MAUNG, N

ART UNIT

PAPER NUMBER

2744

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/442,383**

Applicant(s)  
**Harvey et al.**

Examiner  
**Nay Maung**

Group Art Unit  
**2744**



☒ Responsive to communication(s) filed on Mar 20, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 2-16 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 2-16 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 2, 3, 5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Saeki et al (Saeki).

Consider claim 2. Saeki discloses a method for providing a function at a receiver station (fig. 1, item 2), the receiver station having a data network (fig. 1, item 1), a processor (fig. 2a, item 35), an input device (fig. 2a, item 44), and a data storage device (fig. 2a, item 42), the method comprising the steps of:

receiving from the input device a set of information collection parameters (i.e., a command button 0-10, which is the parameters, for receiving a set of information collection as shown in figs. 4-8, cols. 7-8), each of which is separately inputtable through the input device (i.e., a command button 0-10 which is separately inputtable by a user);

storing the set of information collection parameters at the receiver station (figs. 4-8);

generating a query from the set of information collection parameters at the receiver station (fig. 4, i.e. which information do you need?);

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promulgating the query from the step of generating a query from the receiver station to the data network through the data network connection (the user entering the command, for example, 1 for weather forecast as shown in fig. 4, and promulgating the query, the command, from the receiver station to the data network); and

receiving operating instruction in response to the step of promulgating a query (receiving operating instruction such as display information about the weather; col. 7, lines 3-55);

storing the operating instructions a the storage device (col. 7, lines 3-28).

\*Consider claim 3. Saeki further discloses the steps of processing or outputting information on the basis of the operating system instructions at the receiver station (in fig. 4-8);

storing a data record evidencing the step of processing or outputting (storing a data record, for example, the user input command 1, which is stored in the video data memory 42); and

transferring the data record form the step of processing or outputting from the receiver station storage device to a data collection station on the data network through the data network connection (the data record, the user input command 1 which is transferred to the data collection station for the display information; col. 7, lines 1-55).

Consider claim 5. Saeki discloses a method for providing and tracking a receiver station's (fig. 1, item 2) use of a function in a data network collection station, the receiver station having a data network (fig. 1, item 1), a processor (fig. 2a, item 35), an input device (fig. 2a, item 44), and a data storage device (fig. 2a, item 42), the method comprising the steps of:

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providing operating instructions or executable code to a plurality of receiver stations from the plurality of data source (fig. 1, 27) (fig. 4, col. 7, lines 1-55);

performing a function based on the operating instruction or executable code at the receiver station (fig. 4, col. 7, lines 1-55);

recording an identification (i.e. command 0-10) of the function performed at the step of performing a function at the receiver station on the data storage device (recording an identification, for example the user input command 1, which is transferred to the data collection station for the display information; col. 7, lines 1-55); and

transferring the record of identification of the function performed at the receiver station to a data collection station on the data network through the receiver station network connection (the data record, the user input command 1 which is transferred to the data collection station for the display information; col. 7, lines 1-55).

Consider claim 7. Saeki further discloses the function in the step of performing a function is a series of numerical functions performed on a computer (the command data is performing at the data network computer 26).

3. Claims 8-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Campbell et al (Campbell).

Consider claim 8. Campbell discloses in figure 1 and 2, a method of delivering and gathering information on the use of a control signal in a communication network, the network

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comprising a transmitter station (fig. 1, item 40) and receiver station (fig. 1, item 12, 16), the transmitter station being capable of receiving queries and communicating program materials and data (col. 4, lines 41-48), the receiver station comprising an input device for inputting a command (fig. 2, program source), a processor for receiving programming instruction and communicating information (fig. 2, PCs 50), and a computer for storing data and controlling presentations (fig. 2, PCs 50; col. 7, lines 16-31), the method comprising the steps of:

programming the computer to store a portfolio of data that designate a plurality of personal interests of a subscriber (i.e. weather, news, stock, and other; col. 5, lines 5-15);

querying the transmitter station from the receiver station for data of programming of interest (col. 4, lines 41-48);

receiving, at the receiver station from the transmitter station, some portion of a presentation control signal or some mass medium programming (as depicted in figure. 11) on the basis of a comparison with information stored in the computer (col. 13, lines 1-68);

presenting a unit of mass medium programming at a computer peripheral location (fig. 6, item 104; col. 9, lines 62-68) on the basis of the data or programming of interest received from the transmitter station (i.e. movies are present at the computer peripheral location 36, 40); and

communicating from the receiver station a datum of the unit of mass medium programming or the portion of a presentation control signal (as shown in fig. 11; col. 13, lines 1-68).

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Consider claim 9. Campbell discloses (fig. 1 and 2), a method of controlling a plurality of receiver stations each of which includes a television receiver (40), a signal detector (fig. 6, item 112), a processor (fig. 6, item 104; col. 9, line 62-68), and with each of the receiver station configured to detect the presence of one or more control signals and programmed to process downloadable executable code (as shown in fig. 11), the method of controlling comprising the steps of:

receiving at a transmitter station some downloadable code which is effective at a receiver station to store operating instructions at a storage device associated with a processor, the downloadable executable code having at each of the plurality of receiver stations a target processor to process data (i.e. event enable word as shown in fig. 11 which display a pay-per-view movie at a particular television receiver 40; col. 12, lines 1-34) ;

transferring the downloadable code from the transmitter station (fig. 1, items 10, 11) to a transmitter(fig. 1, item 20);

receiving control signal at the transmitter station, the control signal operate to execute the downloadable code (as depicted in fig. 11); and

transferring the controls signal from the transmitter station to the transmitter, and transmitting at least one information transmission comprising the operating instructions and control signal (as depicted in fig. 11 which is transmitted from the transmitter, the head end station, to the television receiver 40).

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Consider claim 10. Campbell further discloses wherein the downloadable executable code or some identification data in respect of the downloadable executable code are embedded in a television signal (cols. 5 and 6).

Consider claim 11. Campbell further recites wherein a television program is displayed at a receiver station and the downloadable executable code programs the receiver station processor or computer to output video, audio, or text in the context of the television program or to select information that supplements the television program content (col. 7 and 8).

Consider claim 12. Wherein the one or more control signals incorporate some of the downloadable executable code (fig. 11).

Consider claim 13. Campbell discloses (fig. 1) a method of providing a first function to a receiver station (40) from a remote data source (10, 11), the remote data source having operating instructions to control a plurality of different functions (col. 5, lines 1-4) the method comprising the steps of:

storing data at the remote data source (i.e. weather, news, stock, and other; col. 5, lines 5-15);

receiving at the remote data source at least one of (I) a query for said first function or (ii) a record evidencing availability, use, or usage of a second function from the receiver station (for example a user ordering a pay-per-view movie; col. 17, line 42-64);

transmitting an instruct signal which is effective at the receiver station to store operating instructions (tire code) at a storage device associated with a processor from the remote data



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source to the receiver station in response to the step of receiving at least one of the query and the record, the receiver station storing the operating instructions, the operation instructions effective to perform the first of the plurality of different functions (i.e. storing tire code; col. 12, lines 1-34; fig. 11); and

transmitting from a second remote source (fig. 1, item 20) to the receiver station a signal which controls the receiver station to process the operating instructions and perform the first function of the plurality of different functions (i.e. authorization is transmitted the converter, receiver station 40, the data control system at the head end to have access to a given channel, col. 12, lines 27-34; fig. 11).

Consider claim 14. Campbell teaches (fig. 1, 2, 6 & 11) a method of controlling a remote intermediate transmitter station (fig. 1; 11) communicate to at least one receiver station (fig. 2; 40), with the remote intermediate data transmitter station including a broadcast or cablecast transmitter (20), a plurality of selective transfer devices (figs. 1; 12, 16) each operatively connected to said broadcast or cablecast transmitter, a receiver for receiving the operating instructions from at least one ordination transmitter station, a control signal detector, and a controller or computer capable of controlling at least one of the selective transfer devices (as shown in fig. 11), and with the remote intermediate transmitter station configured to detect the presence of at least one control signal, to control the communication of instruction signal (col. 13, lines 1-68), and to deliver at its broadcast or cable cast transmitter the at least one instruction signal, the method communicating comprising the steps of:

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receiving the at least one instruct signal at the at least one origination transmitter station and delivering the at least one instruct signal to at least one origination transmitter (i.e. channel control word, as shown in fig. 11, being effective at the converter 40), the instruct signal being effective at a receiver station to store at least one operating instructions at a storage device (inherently present in the converter 40) associate with a processor (104) (col. 8, lines 18-62; col. 13, lines 25-60);

receiving, at the at least one ordination transmitter station, the at least one control signal (i.e. 201 as depicted in fig. 11) which at the remote intermediate transmitter station operate to control the communication of the instruct signal (col. 4, lines 26-48); and

transmitting the at least one control signal from the at least one ordination transmitter station (i.e. specific movie to be shown at a specific time) to the at least ordination transmitter before a specific time (col. 12, lines 1-34; col. 15, lines 16-39).

Consider claim 15. Campbell further discloses the step of embedding a specific one of the one or more control signals (fig. 11) or in an information transmission containing the instruct signal before transmitting the instruct signal to the remote transmitter station (col. 3, lines 27-43).

Consider claim 16. Campbell further discloses wherein the specific time is a schedule time of transmitting the instruct signal or some information associated with the instruct signal from the remote intermediate data transmitter station and the one or more control signals are effective at the remote intermediate data transmitter station to control one or more of the plurality of selective

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transmission device at different times (i.e. a plurality of user order a pay-per-view movie which is delivered at different time; col. 12, lines 1-34; col. 17, lines 42-64).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saeki et al (Saeki) in view of Block et al. (Block).

Consider claim 4 and 6. Saeki does not explicitly show the receiver station network connection is a telephone network connection. Nevertheless, using a telephone network connection for data transferring is well-known and commonly use in the data communication art as evidenced by Block.

Hence, it would have been obvious to one of ordinary skill in the art to use a telephone network in order to transmit data between a data network and a receiver station, as taught by Block, since telephone networks are commonly located in rural area as opposed to CATV broadcast transmission line.

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*Response to Arguments*

6. Applicant's arguments filed 3/20/98 have been fully considered but they are not persuasive.

7. In the remarks, the applicant argues in substance:

(A) "Claims 2,3,5, and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Saeki...

Claim 2, as amended, recites a step of "receiving from said input device...Accordingly, Saeki fails to disclose a "plurality of data sources"... (PP. 22-23 of the applicants' argument).

In response to the argument (A), claim 2 is still read on Saeki as disclosed above, and a plurality of data sources is read on Saeki's reference, fig. 1, item 26 and 27.

(B) "The Final Office Action asserts that the transmitter station in Campbell is head end combiner 20 and that the receiver station in Campbell is central data control system 12 and television program processor 16..., Campbell fails to satisfy at least the "querying" step and the receiving step" of claim 8, as amended. Campbell fails to disclose that central data control system or television program processor 16 generate any queries to head end combiner 20 because communication is not provided in that direction.

Also, Campbell does not disclose storing a portfolio data that designates a plurality ...Even if Campbell discloses receiving stocks and other information at element 20, that information is not specific to personal interests of a subscriber ..." (P. 24 of the applicants' argument).

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In response to the argument (B), amended claim 8 is still read on Campbell, the receiver station being the addressable converter 40, which can transmit or query to the user TV 36 and to the head end station 20.

(C) “Campbell also fails to disclose all of the feature of claim 9. The Final Office Action asserts that Campbell discloses that the words received in Campbell are “inherently stored.” While that may or may not be the case, those words are not operating instructions because those words do not provide multiple instructions to a processor on how to go about performing a function. Campbell does not receive operating instructions and a control signal where the operating instructions are stored at the receiver station and the control signal executes the operating instructions...” (PP. 24-26 of the applicants’ argument).

In response to the argument (C). No where in the claim show an element, e.g., “multiple instructions to a processor on how to go about performing a function”. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; and thus, the claimed limitations are still read on Campbell as disclosed in paragraph above.

(D) “Campbell also fails to disclose of the elements of claim 13. The final Office Action recites that elements 10, 11 of Campbell satisfy the remote data source and that the element 40 of Campbell satisfies the receiver station element recited in claim 13. Applicants respectfully submit

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that elements 10,11 are not a remote data source. Even if elements 10,11 were considered a remote data source, elements 10,11 do not store data there..." (PP. 26-27 of the applicants' argument).

In response to the argument, Campbell's elements 10, 11 do store data, for example, HVP 52, which is part of element 11, stores data (col. 5, lines 16-35).

(E) "Moreover, in response to these arguments raised in the previous response, the Final Office Action contends that the "limitations" in claim 14" read on Saeki. Again, as discussed above, what Saeki discloses is irrelevant to this rejection because the rejection is under Section 102 over Campbell. (P. 27 of the applicants' argument).

In response to the argument (E), the examiner inadvertently stated that the limitation is read on Saeki instead of Campbell. However, the elements described in the response to the argument is regarding to Campbell's reference, and also the applicant acknowledge, in page 25 footnote of the applicants' argument, that the Final Office Action is referring to Campbell's reference.

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***Conclusion***

**8. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**


(703) 305-9508 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nay Maung whose telephone number is (703) 308-7745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

N. Maung   
May 25, 1998

  
**DWAYNE D. BOST**  
**SUPERVISORY PATENT EXAMINER**  
**GROUP 2700**